

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of		)
		)
	Mitchell et al	)
		)
Serial No.:	09/836,584	) Appeal No.
		)
Confirmation No.	7869	)
		)
Filed:	April 16, 2001	)
		)
For:	Methods and Arrangements for Selectively	)
	Maintaining Parental Access Consent in a	)
	Network Environment	)
		)
Examiner:	Truong, Thaninga B.	)

The Honorable Commissioner of Patents  
Mail Stop Appeal Brief - Patents  
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Alexandria, VA 22313-1450

REPLY BRIEF

The Applicant has filed a timely Notice of Appeal from the action of the Examiner in finally rejecting all of the claims that were considered in this application. This Brief is being filed under the provisions of 37 C.F.R. § 1.193. An extension of time, as set forth in 37 C.F.R. § 1.136(b), is submitted herewith.

## ARGUMENT

### First, Second and Third Grounds of Rejection.

Claims 1-47 satisfy the requirements of 35 U.S.C. § 102 and were not properly rejected as being anticipated by U.S. Patent No. 5,678,041 to Baker et al (hereinafter "Baker").

### The Examiner uses an Improper Standard of "Obvious to Try" in each of the Anticipation Rejections

The Examiner, in the Examiner's Answer Dated January 12, 2006, asserts the following in relation to Claim 1:

It will be understood that the invention **could be modified** so that the list of user clearances associated with a given user terminal identification code serves as a restrictive list 91.e.; that user is not allowed to retrieve network resources having that rating). This restrictive listing functionality **could be readily facilitated by reprogramming processor 111**. In addition, **the invention could be modified** so that the identification codes recognized by processor 111 and stored in relation database 114 are user specific, as opposed to user terminal specific. In other words, **the system of Figure 1 could be modified** so that a given individual using a terminal is identified to the system by a personal password or other identifying code. Access or denial of the transmission of particular URLs is effected [sic] by the system as a function of that person's identity, regardless of the particular user terminal they may be utilizing (column 5, lines 45-65). *See Examiner's Answer, Page 4 (emphasis added).*

It is respectfully submitted that this is clearly not in compliance with the standard of anticipation. As is well settled, anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs.*

v. *Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Thus, it is clear that in an anticipation rejection, the reference must teach every element and further the reference may not be modified.

In the present case, however, it is respectfully submitted that not only has the Examiner failed to apply a correct anticipation standard, but also has not met the requirements for obviousness. It is also well settled that “the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). Thus, it is respectfully submitted that even assuming for the sake of

argument alone that such modification could be made under an obviousness rejection, the reference does not disclose any motivation to make such modification.

Rather, the Examiner seems to apply an “obvious to try” standard, which is well settled as impermissible as supported by the following excerpt.

The Dean statement is of the type that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it. **Such a suggestion may make an approach “obvious to try” but it does not make the invention obvious.** .... We recognize that given the teaching in appellant’s specification regarding incorporation of the gene into the chromosome and utilizing the bacteria in the plant environment, one can theoretically explain the technological rationale for the claimed invention using selected teaching from the references. This approach, however, has been criticized by our reviewing court as hindsight reconstruction. *Ex parte Obukowicz at 1065 (emphasis added)*.

Thus, the Reference does not support an anticipation nor an obviousness rejection.

Similar deficiencies may be found throughout the Examiner’s Answer. For example, with reference to claim 10, the Examiner asserts “the submitted requests are assumed to be in the form of URLs”. *See Examiner’s Answer, Page 5*. In another example, the “above described system may also be modified so that URLs are identified as being in a rating category within the memory structure of a relational database”. *See Examiner’s Answer, Pages 6-7*. In yet another example, “the system could also be implemented so that the list of user clearances associated with a given user terminal identification cod serves as a restrictive list .... This restrictive listing

functionality could be readily facilitated by reprogramming processor 111", but does not provide support for the statement. See *Examiner's Answer*, Page 9.


The Applicant respectfully requests that the Board overturn the First, Second and Third Grounds of Rejection as being improperly rejected under both an anticipation and an obviousness standard.

### CONCLUSION

The Applicant respectfully considers this application to be in condition for allowance and respectfully requests the Board to overturn the final rejection and that the Examiner pass this application to allowance.

Dated this 12th day of May, 2005.

Respectfully submitted,

  
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